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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/150,577

09/10/1998

DENNIS M. O'CONNOR

INTL-0100-US

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21906

7590

02/23/2005

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EXAMINER

CHEVALIER, ROBERT

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 02/23/2005

LC

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/150,577

Applicant(s)

O'CONNOR ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 26, 28-31, 33-37, are 39-41, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-10 of U.S. Patent No. 6,480,667. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in the patented claims 6-10, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the patented claims 6-10, would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the patented claims 6-10, including the claimed feature recited in claims 26, 31, and 36-37, of displaying the video stream from the storage device and when the time delay is less than a predetermined threshold, displaying the video stream without storing said

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stream. Applicant's attention is directed to the patented claim 6, of U.S. Patent No. 6,480,667.

With regard to claims 28, 33, and 39, the feature of allowing one or more portions of the video stream to be read from the storage device to retrieve the video stream with one or more time delays that are user-specified as specified thereof is present in the patented claim 8, of U.S. Patent No. 6,480,667.

With regard to claims 29, 34, and 40, the feature of the video stream further comprising allowing the video stream to be compressed prior to writing the video stream to the storage device as specified thereof is present in the patent claim 9, of U.S. Patent No. 6,480,667.

With regard to claims 30, 35, and 41, the feature of displaying the video stream from the storage device when the time delay is greater than the predetermined threshold comprising decompressing the video stream after retrieving the video stream from the storage device as specified thereof is present in the patented claim 10, of U.S. Patent No. 6,480,667.

3. Claims 27, 32, 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,480,667 in view of Sata et al and Honjo.

U.S. Patent No. 6,480,667, discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 27, 32, and 38, including the feature of recording and reading video data to and from the storage medium as

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specified in the present claims 27, 32, and 38. (See the patented claim 6, of U.S. Patent No. 6,480, 667).

the patented claim 6, of U.S. Patent No. 6,480, 667, fails to specifically disclose the feature of writing to the storage medium while reading from the storage medium as specified in the present claim 27, 32, and 38.

Sata et al discloses a video recording/reproducing apparatus that shows the claimed feature of writing to the storage medium while reading from the storage medium as specified in the present claim 27, 32, and 38. (See Sata et al's Figure 4).

It would have been obvious to one skilled in the art to modify the patented claim 6, of U.S. Patent No. 6,480,667, wherein the recording/reading means provided thereof would incorporate the capability of writing video data to the storage medium while reading video data from the storage medium in the same conventional manner as is shown by Sata et al. The motivation is to be able to simultaneously writing and reading video data to and from the recording medium, thereby increase the accessing speed during reproduction operation as suggested by Sata et al.

It is further noted that the proposed combination of the patented claim 6 of U.S. Patent No. 6,480,667, and the Sata et al's reference indicated above fails to disclose the feature of storing in a temporary buffer the portion of the video stream to be written to the storage device as specified in the present claims 27, 32, and 38.

Honjo does disclose a video recording/reproducing apparatus which includes the capability of storing in a temporary buffer the portion of the video stream to be written to

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the storage device as specified in the present claims 27, 32, and 38. (See Honjo's Figure 1, component 2, and 7).

It would have been obvious to one skilled in the art to modify the proposed combination indicated above wherein the recording means provided thereof would incorporate the capability of storing in a temporary buffer the portion of the video stream to be written to the storage device in the same conventional manner as is shown by Honjo. The motivation is to better control the transmission rate of the video data provided for recording in the storage medium as suggested by Honjo.

#### ***Conclusion***


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier  
February 16, 2005.

  
ROBERT CHEVALIER  
PRIMARY EXAMINER